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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			BATTULA, PRADEEP CHOUDARY	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,233

Applicant(s)

BLOHM ET AL.

Examiner

Pradeep C. Battula

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 March 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

1. The drawings are objected to because of minor informalities. In Figure 6, the last box states the "Reject Book" step but according to the specifications this should be the "Bundling" step. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 14, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
 - a. Regarding Claim 8, neither the specifications nor the drawings contain any indication on how the alternate piece will be generated and sent to the recipient in electronic format.
 - b. Regarding Claim 14, neither the specifications nor the drawings contain any indication on how the alternate piece will be generated and sent to the recipient in electronic format.

- c. Regarding Claim 20, neither the specifications nor the drawings contain any indication on how the alternate piece will be generated and sent to the recipient in electronic format.
- 3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Line 5 of Claim 21 is indefinite because the drawings and specifications declare the binding line as the machine in Figure 1 of the drawings. In Claim 21 it is stated that the binding line is not the machine in Figure 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 4. Claims 1-3, 5-7, 9-12, 15-17, 19, 24, 25, 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al (Anderson). (U.S. 3,819,173).

- a. Regarding Claim 1, Anderson discloses a binding method comprising:
generating a pre-personalized book on a binding line for a specific individual; rejecting selective pre-personalized books; and generating an

alternate piece in place of each rejected pre-personalized book to be delivered to the specific individual (Column 1, Lines 37-65).

- b. Regarding Claim 2, Anderson discloses that the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63).
- c. Regarding Claim 3, Anderson discloses that the pre-personalized book includes a pre-personalized signature (Column 1, Lines 8-10).
- d. Regarding Claim 5, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63).
- e. Regarding Claim 6, Anderson discloses the alternate piece is a printed product (Column 1, Lines 58-63).
- f. Regarding Claim 7, Anderson discloses an alternate piece that is a postcard (Column 1, Lines 58-63).
- g. Regarding Claim 9, Anderson discloses a binding method comprising: generating a mailing list of recipients; generating a pre-personalized book for each recipient on a binding line; rejecting selective pre-personalized books; identifying the recipient of each rejected pre-personalized book; and generating an alternate piece for each rejected pre-personalized book (Column 1, Lines 37-65).
- h. Regarding Claim 10, Anderson discloses the alternate piece is a printed product (Column 1, Lines 58-63).

- i. Regarding Claim 11, Anderson discloses the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63).
- j. Regarding Claim 12, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63).
- k. Regarding Claim 15, Anderson discloses a method of replacing a rejected book on a binding line, the method comprising: generating a mailing list of recipients having a mailing order; assembling a pre-personalized book on the binding line for each recipient according to the mailing list; rejecting selective pre-personalized books; and generating an alternate piece on the binding line to replace the rejected pre-personalized book, the alternate piece positioned on the binding line to maintain the mailing order (Column 1, Lines 37-65).
- l. Regarding Claim 16, Anderson discloses an alternate piece that is a postcard (Column 1, Lines 58-63).
- m. Regarding Claim 17, Anderson discloses the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information of the pre-personalized book (Column 1, Lines 58-63).
- n. Regarding Claim 19, Anderson discloses the alternate piece is a printed product (Column 1, Lines 58-63).

- o. Regarding Claim 24, Anderson discloses a binding method comprising:
generating a pre-personalized book on a binding line for a specific individual, the book having therein a portion containing pre-personalized information; rejecting selective pre-personalized books; reprinting the portion of each rejected book; then regenerating the pre-personalized book on the binding line for the specific individual to include the portion (Column 1, Lines 37-65).
- p. Regarding Claim 25, Anderson discloses the step of reprinting the portion is done on the binding line (Column 1, Lines 58-63).
- q. Regarding Claim 27, Anderson discloses the portion is a signature (Column 1, Lines 8-10).
- r. Regarding Claim 28, Anderson discloses a binding method comprising:
generating a mailing list of recipients; generating a pre-personalized printed product for each recipient; assembling a first book on the binding line for each recipient, said assembly including a respective pre-personalized piece; rejecting selective first books; reprinting the pre-personalized printed product for each recipient whose first book was rejected; then assembling a second book on the binding line for each recipient whose first book was rejected, said assembly including the reprinted pre-personalized printed product (Column 1, Lines 37-65).
- s. Regarding Claim 29, Anderson discloses the reprinting step is done on the binding line (Column 1, Lines 58-65).

5. Claims 21 and 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Graushar et al (Graushar). (U.S. 6,347,260).
- a. Regarding Claim 21, Graushar discloses a binding method comprising: generating a mailing list of recipients; generating a pre-personalized printed product off-line for selected recipients on the mailing list; the ability to load the pre-personalized printed products adjacent the binding line (Figure 1, Item 14); assembling a book for each recipient including a respective pre-personalized printed product; rejecting selective recipients books; and generating an alternate piece for each rejected book (Column 2, Lines 1-15 and Column 3, Lines 1-3).
 - b. Regarding Claim 23, Graushar discloses the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 3, Lines 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4, 13, 18, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Clark (U.S. 5,428,423).

- a. Regarding Claim 4, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on line with respect to the binding line (Column 1, Lines 58-63).

Anderson does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

- b. Regarding Claim 13, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on line with respect to the binding line (Column 1, Lines 58-63).

Anderson does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to

include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

- c. Regarding Claim 18, Anderson discloses the generation of an alternate piece that contains the same information as the pre-personalized book (Column 1, Lines 58-63).

Anderson does not disclose how to make the alternate piece's information different from the books pre-personalized information.

Clark discloses a printer which takes input information and will print the same information onto an alternate piece. The information can be customized so, it be the same or different from the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's printing method to provide the ability to alter the pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

- d. Regarding Claim 26, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on line with respect to the binding line (Column 1, Lines 58-63).

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Anderson does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

- e. Regarding Claim 30, Anderson discloses the act of generating the alternate piece includes printing the alternate piece on line with respect to the binding line (Column 1, Lines 58-63).

Anderson does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient

they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar in view of Clark.

a. Regarding Claim 22, Graushar discloses an alternate piece and also discloses that an alternate piece can be loaded adjacent the binding line. Graushar does not disclose that the alternate piece produced has at least a portion of the pre-personalized information the pre-personalized book contains.

Clark discloses a method of printing that produces a pre-personalized printed product that can be produced offline as an alternate piece and customized to include a portion of the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Graushar's method to include the use of Clark's off-line printing to provide the ability to use some of pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Grausher. Both Grausher and Anderson disclose a generation of a mailing list of recipients, on line assembly of pre-personalized books for each recipient, rejecting selected books and then replacing them (Anderson: Column 1, Lines 48-65; Grausher: Column 2, Lines 1-15). They each disclose a different replacement. Anderson discloses a replacement that is either a regenerated book identical to what the rejected book should have been or, the generation of an alternate piece (Column 1, Lines 58 – 64). Grausher discloses the replacement being a generic book (Column 3, Lines 1-3). Therefore, it would have been obvious to a person having ordinary skill in the art that at the time the invention was made to alter Anderson's method to include the generic book replacement in Grausher's method. The motivation would be to give the customer exactly what they wanted and if not possible, give the customer something similar to what they wanted in order to avoid problems.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-0000. The examiner can normally be reached on Monday - Friday 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MONICA CARTER
SUPERVISORY PATENT EXAMINER

Pradeep Battula
Patent Examiner
May 9, 2006